

REMARKS

Applicant respectfully requests entry of the amendments and consideration of the remarks submitted herein. Claims 34-41 have been canceled. Accordingly, claims 1-33 are pending.

Claims 34-41 have been canceled to remove non-elected subject matter. These claims were not canceled for any reasons related to patentability. Accordingly, the pending claims will be entitled to a full scope of equivalents upon issuance of the patent. Applicant reserves the right to pursue the subject matter of the canceled claims in one or more divisional applications.

Restriction/Election

Applicant respectfully traverses the proposed narrowing of the claimed subject matter beyond the Examiner's previously defined Group I, claims 1-33. The Examiner has not provided any rationale for narrowing the scope of R₂ by removing the single diphosphate group as suggested at page 3 of the Office Action. In addition, it is respectfully submitted that there is no rationale to limit the scope of the R₁ "detectable group" since this clearly refers to "any known fluorophore substituent, for example, fluorescent groups including, but not limited to, anthranilic acid compounds, aminonaphthalenesulfonic acid compounds, coumarin compounds and like groups or compounds and as illustrated herein." Accordingly, the Examiner is respectfully requested to examine the full scope of the claims as presented.

Rejections under 35 U.S.C. § 112, First Paragraph

At page 4 of the Office Action the Examiner states that the specification, while being enabling for methods for treating diseases such as allergies, allergic bronchopulmonary aspergillosis, etc., does not reasonably provide enablement for the prevention of said diseases. The cancellation of the non-elected subject matter of claims 34-41 is believed to obviate this ground for rejection.

In addition, at page 5 of the Office Action, the Examiner states that "the specification discloses a narrow synthetic scheme for the preparation of formula (I) wherein X is an amine but does not provide guidance to make the compounds of formula (I) where X is oxygen or sulfur-citing to page 19, Example 1. In response, Applicant submits that the claimed compounds are not complicated structures. Accordingly, one skilled in the art could make the claimed compounds, without undue experimentation, in the absence of any teaching from the specification regarding how they could be prepared.

Additionally, Applicant respectfully submits that the specification is replete with information that would allow one of ordinary skill in the art to make and use the claimed compounds without undue experimentation. See *In re Wands* 858 F.2d 731, 737 (Fed. Cir. 1998). In fact, Applicant's specification provides broad teaching for how to make and use the claimed compounds including those compounds having X as sulfur or oxygen. Enablement is viewed in the context of the entire specification including, but not limited to, the working examples in the specification. The specification clearly teaches that X is independently -NRa-, O or S in a compound of formula I. The claims of this divisional application however, are limited to those compounds having X as independently O or S.

The Detailed Description of the specification refers to specific values of X that include the various amines as well as oxygen and sulfur. The specification also states that "[p]rocesses and novel intermediates useful for preparing compounds of formula I are provided as further embodiments of the invention and are illustrated by the following procedures in which the meanings of the generic radicals are as given...and [c]ompounds of the invention...can be prepared in accordance with the preparative schemes described below." The specification therefore directs one of ordinary skill in the art to prepare the compounds of the invention according to the preparative schemes as shown. In the sentence preceding Example 1, one of ordinary skill in the art is also reminded that "[o]ther features of the invention will become apparent in the course of the following description of exemplary embodiments where are given for illustration of the invention and are not intended to be limiting hereof."

Example 1 has the header that states "Preparation of Fluorescent Analog Compounds," which clearly directs one of ordinary skill in the art to use the synthetic schemes therein or analogous schemes as general or specific methods to make such compounds, even if specific compounds are actually made in the schemes. One of ordinary skill in the art is clearly directed, for example, to simply replace the amine reactant illustrated in the scheme with a corresponding oxygen or sulfur analog to provide a sulfur or oxygen analog of compound 56 or 60 as shown in Scheme 1 (or compound 69 or 72 in Scheme 2). In addition, removal of the acetate functionality to the enol and subsequent phosphorylation would readily be accomplished by a similar route depicted in Schemes 1 and 2 for the sulfur or oxygen analogs.

It is respectfully submitted that one of ordinary skill in the organic synthesis arts can clearly recognize distinctions between amine functionalities and oxygen or sulfur precursors and

can modify the reactants accordingly to form the compounds of the invention having X as oxygen or sulfur. Phenolic compounds and sulfur substituted aryl starting moieties are well known and one of ordinary skill in the art using the schemes shown in the specification (or similar approaches) can readily prepare analogous reactions for those compounds having X as S or O without undue experimentation. Applicant thus respectfully requests that the Examiner withdraw this basis of rejection and allow all pending claims.

Claim Objection-Non Elected Subject Matter

Claims 34-41 have been canceled to remove non-elected subject matter. Additionally, as discussed in detail above, Applicant respectfully requests that the Examiner search and examine the full scope of Restriction Group I as previously presented. Please see M.P.E.P. 803.

CONCLUSION

The Examiner is invited to contact Applicant's Representative at the below-listed telephone number if there are any questions regarding this Response or if prosecution of this application may be assisted thereby.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3503. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extension fees to Deposit Account 50-3503.

Respectfully submitted,

David Wiemer et al.

By their Representatives,

Viksnins Harris & Padys PLLP

Customer Number 53137

PO Box 111098

St. Paul, MN 55111-1098

(952) 876-4092

Date: 5-31-07

By: 

Robert J. Harris

Reg. No. 37,346